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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES DUNCAN WORK

Appeal 2009-001388
Application 09/852,336¹
Technology Center 2400

Decided: December 24, 2009

Before LEE E. BARRETT, LANCE LEONARD BARRY, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 148-152, 155, 156, 158, 161, 162, and 172-178.

Claims 1-147, 153, 154, 157, 159, 160, and 163-171 have been canceled.

We have jurisdiction pursuant to 35 U.S.C. § 6(b).

A telephonic hearing was held on December 10, 2009.

We reverse.

¹ Filed May 8, 2001, titled "Method and Apparatus for Internet-Based Human Network Brokering," which claims the benefit of Provisional Application 60/203,374, filed May 9, 2000.

STATEMENT OF THE CASE

The invention

The invention relates to a computer implemented "people-networking" scheme. User enter profile information into a profile builder including their capabilities, projects, goals, and values so that others can adequately find and evaluate them. Spec. ¶ [0052]. The users also describe their "relationship networks" of contacts, clients, partners, and others with certain specified expertise, industry affiliations, locations, professions, personal or social interests, or any other user-defined criteria. Spec. ¶ [0054]. Users define access criteria to allow access to the profile information in a personal access agent. Spec. ¶¶ [0064], [0079]. Access control criteria define ranked access levels assigned to these one or more persons. Spec. ¶ [0065]. The access levels may be defined in terms of attributes that exist between two people in the chain of person-to-person relationships. Spec. ¶¶ [0069], [0073]. The access control criteria may include connection strength. Spec. ¶ [0107]. Matches between search queries and potential targets must satisfy the access control criteria as well as the search criteria.

Illustrative claims

Independent claims 148 and 172 are reproduced below:

148. A computer implemented method, comprising reporting matches to searches initialed by a searcher so long as access control criteria are met, the matches including potential targets satisfying one or more search criteria defined for the searches, and the access control criteria (i) being selectably controllable by any of one or more persons in one or more chains of person-to-person relationships connecting and including the searcher and the potential targets, and (ii) defining ranked access levels assigned to said one or more persons, said access levels being defined in terms of attributes of relationships that exist between any two persons in each of said chains of person-to-person relationships connecting the searcher and the potential target to which each of the matches pertain.

172. A computer-implemented method, comprising reporting matches to search criteria specified in a search initiated by a searcher so long as a connection strength between each two people forming a person-to-person connection in a chain of person-to-person connections between the searcher and a potential target exceeds a connection strength threshold, said connection strength being an attribute of access control criteria that are selectably controllable by any of one or more persons in said chain of person-to-person connections between the searcher and the potential target.

The references

Walker US 5,884,270 Mar. 16, 1999

Kautz et al., *The Hidden Web*, American Association for Artificial Intelligence, 1997, pp. 27-36 ("Kautz").

Michalski, *Collaborative Filters*, Release 1.0 - Esther Dyson's Monthly Report, Nov. 1996 ("Michalski").

The rejections

Claims 148, 150, 155, 156, 158, 172, 174, 177, and 178 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Michalski.

Claims 149, 173, 175, and 176 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Michalski.

Claims 151 and 152 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Michalski and Kautz.

Claims 161 and 162 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Michalski and Walker.

DISCUSSION

Enablement

Appellant argues that Michalski does not provide an enabling disclosure of each and every limitation of the claims and therefore cannot serve as a basis for rejecting the claims. Br. 5-6.

The Examiner responds that Appellant has not provided any evidence that it would take undue experimentation for one of ordinary skill in the art to implement the claimed invention and concludes that one of ordinary skill in the computer art could implement the features of Michalski. Ans. 7.

Appellant argues that the brief descriptions in Michalski would not have been enabling. Reply Br. 4-7.

Before we get to the issue of enablement, we must first determine whether the reference describes the claimed subject matter. In this case, we do not need to decide the question of enablement.

Claims 148-152, 155, 156, 158, 161, 162, and 176-178

Contentions

Appellant argues that Michalski does not describe reporting matches if access control criteria are met, "the access control criteria . . . being selectably controllable by any of one or more persons in one or more chains of person-to-person relationships connecting and including the searcher and the potential targets" as recited in claim 148. Br. 6-7; Reply Br. 7.

The Examiner relies on paragraph one on page 15 of Michalski for this limitation in the statement of the rejection in the Final Rejection and Answer.

Appellant argues that Michalski does not describe a system in which matches are reported based on "chains of person-to-person relationships" that are established between the searcher and a target. Br. 7. It is argued that paragraph one of Michalski does not disclose or suggest selectably controllable access control criteria or a system in which chains of person-to-person relationships are formed, in part based on access control criteria that are established by each person. *Id.* It is argued that paragraph six refers to "informal networks of people," but does not define the term or state how it is implemented and does not teach the limitation at issue. *Id.*

Appellant argues that Michalski does not describe that how "levels of trust" are implemented, and does not indicate who sets the levels of trust or what information or attributes the trust levels apply to. Br. 5.

Appellant also argues that Michalski does not describe ranked "access levels being defined in terms of attributes of relationships that exist between

any two persons in each of said chains of person-to-person relationships" because the term "level of trust" in Michalski may imply a rating, but it does not imply that there need be a personal relationship between the person doing the rating and the person being rated. Br. 6. It is argued that Michalski does not describe how the levels of participation and trust are implemented and/or used. *Id.* at 5.

In the response to Appellant's arguments, the Examiner shifts position and finds that "the chains of person-to-person relationships is taught by the levels of trust that are controllable by a guarding gatekeeper that a person-to-person relationship shares when the network brokers goes and searches for people (see page 15, paragraph 15 [sic, 5])." Ans. 8.

Claim interpretation

Initially, we interpret claim 148 to require that all steps are computer implemented, except for initiating the search by entering search criteria and setting the access levels, which are done by a user. We interpret the limitation "the access control criteria (i) being selectably controllable by any of one or more persons in one or more chains of person-to-person relationships . . . , and (ii) defining ranked access levels assigned to said one or more persons" to mean that the "access control criteria" are "ranked access levels" which are "selectably controllable" by persons in the chains of relationships. The limitation of "access levels being defined in terms of attributes of relationships that exist between any two persons in each of said

chains of person-to-person relationships" limits the access levels to attributes of relationships between two persons.

Issue

At the telephonic oral hearing, Appellant argued that Michalski did not meet the limitation of "reporting matches." Appellant stated that this argument was presented in the Reply Brief. We do not find arguments that focus on this specific limitation in the Brief or the Reply Brief and, so, the argument will not be considered. *See* 37 C.F.R. § 41.37(v)(1)(vii) ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.").

Thus, the issue is:

Has Appellant show that the Examiner erred in finding that Michalski describes the limitations of claim 148, in particular, the limitations of: (1) "chains of person-to-person relationships"; (2) "access control criteria . . . being selectably controllable by any of one or more persons in one or more chains of person-to-person relationships; and (3) "access levels being defined in terms of attributes of relationships that exist between any two persons in each of said chains of person-to-person relationships"?

Principle of law

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

Findings of fact

Michalski is a report about systems that use "collaborative filters." The relevant part of Michalski is found in the description of "Net Deva" (short for Net Development Associates) at page 15, paragraphs one to six.

Michalski reports on an interview with the Duncan Work, the named inventor on the present application.

Michalski describes a "collaborative filter" for "collecting, linking and automating multiple annotated Rolodexes over the Net in a way that helps people build teams, staff projects, make introductions and close deals." Page 15, paragraph 3.

Michalski mentions personal search agents, gatekeeper agents, and network broker agents.

The specific teachings of Michalski are discussed in the Analysis.

Analysis

It is clear the Examiner relies on Michalski because it describes the work of the inventor of the present application. Nevertheless, while Michalski uses some of the same terms as the Specification, such as

"network broker," "profiles," "contacts," "gatekeeper," and "personal search agents," it must still describe the claimed invention.

The Examiner's finding that "the chains of person-to-person relationships is taught by the levels of trust that are controllable by a guarding gatekeeper that a person-to-person relationship shares when the network brokers goes and searches for people" (Ans. 8) is unclear. "Chains of person-to-person relationships" refers to the connections among persons, whereas "levels of trust" (also called "trust levels") best corresponds to "access control criteria"; thus, it is confusing to say that "chains of person-to-person relationships" is taught by "levels of trust." However, since this is an anticipation rejection based on one page of a reference, we look at Michalski's entire description of "Net Deva" on page 15.

Michalski describes a system for "linking and automating multiple annotated Rolodexes over the Net" (page 15, paragraph three) and "Net Deva helps link informal networks of people" (page 15, paragraph six). A Rolodex is an individual's contact list. The description of "linking" Rolodexes and networks of people fairly teaches "chains of person-to-person relationships." The description of the personal search agent asking "do you know anyone in the Department of Justice? who has done business in Peru" (page 15, paragraph four), indicates asking one entity which provides information about another entity, which is at least a two link chain. Michalski reasonably implies that a match to the search query will be reported back to the user. The claimed chains of relationships do not have to

be any certain length, although at least two links are implied. Thus, we find that Michalski teaches "chains of person-to-person relationships."

The terms "levels of trust" or "trust levels" initially sound like the claimed "ranked access levels" since Michalski's gatekeeper agent allows access based on the trust level of the agents making the request. However, we see two problems. First, claim 148 recites that the access control criteria are "selectively controllable" by the users. We agree with Appellant that Michalski does not describe that how "levels of trust" are implemented, and does not indicate who sets the levels of trust or what information or attributes the trust levels apply to. While, perhaps, it is implied that the user sets the levels of trust, this is an anticipation rejection and there is not enough information to make this finding without speculation. Second, even if the user did set the trust levels, claim 148 recites the "access levels being defined in terms of attributes of relationships that exist between any two persons in each of said chains of person-to-person relationships." We agree with Appellant that the term "level of trust" in Michalski does not imply that there need be a personal relationship between the person doing the rating and the person being rated. The rejection does not address these deficiencies in Michalski, either of which is sufficient to reverse. Thus, we conclude that Appellant has shown error in the rejection.

Conclusion

Appellant has shown error in the anticipation rejection of independent claim 148. Accordingly, the rejection of claims 148, 150, 155, 156, 158, 177, and 178 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection over Michalski does not cure the deficiencies in the anticipation rejection over Michalski. Accordingly, the rejection of claims 149 and 176 under 35 U.S.C. § 103(a) is reversed.

Kautz does not cure the deficiencies in the anticipation rejection of claim 148. Accordingly, the rejection of claims 151 and 152 under 35 U.S.C. § 103(a) is reversed.

Walker does not cure the deficiencies in the anticipation rejection of claim 148. Accordingly, the rejection of claims 161 and 162 under 35 U.S.C. § 103(a) is reversed.

Claims 172-175

Contentions

Appellant argues that Michalski does not describe "reporting matches . . . so long as a connection strength between each two people forming a person-to-person connection in a chain of person-to-person connections between the searcher and a potential target exceeds a connection strength threshold" as recited in independent claim 172. Br. 7-8; Reply Br. 8.

The Examiner relies on paragraph five of page 15 in Michalski, quoted *supra*.

Appellant argues that this paragraph does not disclose or suggest a "connection strength." Br. 7. Appellant argues that paragraph four refers to "trust levels," but the term has not been defined and it is not the same as a "connection strength" or a "connection strength threshold." *Id.* It is argued that to the extent a trust level is similar to a connection strength, Michalski does not teach reporting matches when a trust level between two people forming a person-to-person connection between the searcher and a potential target exceeds a threshold. *Id.*

The Examiner responds:

Michalski discloses that personal information is available to the network broker, but not individuals, unless it is specifically allowed by the guarding gatekeeper. Furthermore, disclosing that the personal gatekeeper agents are able to give access at varying levels of security based on the levels of trust (i.e. if a person meets the level of trust, information will be available to the individual doing the searching). The claim does not clearly define what the connection strength consists of. Therefore, the Examiner believes this provides enough evidence to teach a connection strength (i.e. how well do you trust someone) between two people and exceeding a connection threshold by meeting the level of security based on the level of trust (i.e. if you trust them enough, give them information).

Ans. 8.

Issue

Has Appellant show that the Examiner erred in finding that Michalski describes the limitations of claim 172, in particular, the limitations of :

(1) "a connection strength between each two people forming a person-to-person connection in a chain of person-to-person connections";

(2) the "connection strength . . . exceeds a connection strength threshold"; and (3) the connection strength "being an attribute of access control criteria that are selectably controllable by any of one or more persons in said chain of person-to-person connections"?

Analysis

The Examiner concludes that "connection strength" is not defined in the claims and therefore is met by the "level of trust" in Michalski. However, we interpret that "a connection strength between each two people forming a person-to-person connection" requires some attribute defining the connection between the persons. The "level of trust" in Michalski is not described in enough detail to determine whether it is such an attribute of trust between two persons. Furthermore, as noted in the discussion of claim 148, Michalski does not expressly describe that such an attribute is "selectably controllable" by the users and such a feature cannot be said to be inherent. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set circumstance is not sufficient." *In re Oelrich*, 666 F.2d 578, 581 (1981) (quoting *Hansgird v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)). Michalski does not provide enough description of the system to find that it anticipates the claimed subject matter.

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Conclusion

Appellant has shown error in the anticipation rejection of independent claim 172. Accordingly, the rejection of claims 172 and 174 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection over Michalski does not cure the deficiencies in the anticipation rejection. Accordingly, the rejection of claims 173 and 175 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

The rejections of claims 148-152, 155, 156, 158, 161, 162, and 172-178 are reversed.

REVERSED

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